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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,023	01/10/2002	Toshihiro Morita	450101-02844	4611
22850 7590 07/18/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER CHEN, TE Y	
			ART UNIT 2161	PAPER NUMBER
			NOTIFICATION DATE 07/18/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Office Action Summary**

Application No.

09/889,023

Applicant(s)

MORITA ET AL.

Examiner

Susan Y. Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 41-43 and 48-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-43 and 48-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/10/07</u> . | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

This office action is in response to the amendment filed on April 11, 2007.

***Claim Status***

Claims 41-43, 48-68 are pending for examination, claims 41, 48, 53, 55, 60, 62, 67-68 have been amended.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 41-43 and 48-68, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,412,012 issued to Bieganski et al. (hereinafter referred as '012 Bieganski) in view of U.S. Patent No. 6,959,288 issued to Medina et al. (hereinafter referred as '288 Medina).

Claims 41, 48, 53, 55, 60, 62 and 67-68:

Bieganski discloses an information processing system as claimed [e.g., Fig. 1] comprising:

- a recording unit for recording usage history data and the related data recorded in the recording means based on at least two filtering data set, wherein, each of the at least two filtering dataset defining a filtering criteria as a computation of a weight per each contents. [e.g., the CPU (102, Fig. 1) can coupled to the memory system (104, Fig. 1) and the secondary storage(108 of Fig. 1) to log history data indicative of usage history of the group of contents. Furthermore, the data being stored in the History Set (203, Fig. 2) and the customer's behavior data recorded at a shopping set as specified at col. 8, lines 7-8, and the Purchased Items associated to a particular user's Transaction, and the item compatibility rule data sets at (900, Fig. 9), and the recommendation sets generated by the engine (600, Fig. 14; col. 14, lines 31-33), wherein the at least two filtering data set (e.g., the units: 303, 305, 306, Fig. 3 and associated texts) are deemed to define as filtering criteria as a computation of a weight per each contents in the recommendation set (e.g., col. 3, lines 48-58)];
- a computing unit configured to compute a weight related to a number of checkout per each of the contents based on both the history data and one of the at least two filtering data set [e.g., the compatibility modifier (200, Fig. 2) of the collaborative filtering system can accept a stored number of checkout (or the number of

times each item was purchased, Fig. 9) per each of the contents from the history data on a filtering rule specified by a marketer or customer or the processing of recommendation engine itself (col. 9, lines 63-49) to compute a weight related to the number of checkout (the steps 752-756, Fig. 7A)], wherein, the computing unit receiving input from a user to define the filtering criteria of the at least two filtering data sets [e.g., the collaborative filtering systems at col. 6, lines 4-6];

- a selecting unit for selecting a content from a group of contents based on weight computed by the computing means [e.g., the user interface adapter coupled to the Input Device (114, 118, Fig. 1) can be used to select the modified recommendation set based on weight computed by the compatibility modifier (Fig. 5; Fig. 6; col. 13, line 21 - col. 14, line 14; col. 14, line 31-col. 15, line 2)];
- a displaying unit for display a list of at least titles in the information related to the contents selected by the selecting means [e.g., the Display Adapter (112, Fig. 1) coupled to the Display Device (116, Fig. 1) can display a list of recommended books selected by the book reviewer (col. 7, lines 49-54)].

'012 Bieganski did not directly explain that the selection unit configured to create at least two filtering packages based on the at least two filtering data sets, wherein each

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of the at least two filtering packages includes information identifying the content selected, and the information identify the content is capable of being shared by at least two filtering packages so as to allow the content to belong to both the at least two filtering package at any given time.

However, '288 Medina discloses the claimed features [e.g., col. 11, lines 7-30, col. 68, lines 13-67, the content processing tool of Fig.(s) 8, 12-13 and associated texts]

'012 Bieganski and '288 Medina are in the same endeavor to facilitate the sharing of group of content data via open network user interface, therefore, with the teachings of Bieganski and Medina in front of him/her, it would have been obvious for one of the ordinary skill person in the art at the time the invention was made to modify Bieganski's system with the technique taught by Medina to provide the selection unit as claimed that is configured to create at least two filtering packages based on the at least two filtering data sets, wherein each of the at least two filtering packages includes information identifying the content selected, and the information identify the content is capable of being shared by at least two filtering packages so as to allow the content to belong to both the at least two filtering package at any given time. Because by doing so, as suggested by Medina the combined system will provides a standard for creating digital players on end-user device that facilitates an end user to distribute, share and manage of a local library of digital contents no other than what was purchased [e.g., col. 5, lines 39-53, Fig.(s) 8, 12-13 and associated texts].

As to claims 42, 49, 51-52, 54, 56, 58-59, 61, 63, and 65-66:

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Except all the features recited in claims 41, 48, 53, 55, 60, and 62, the combined system of Bieganski and Medina further discloses that the system comprising means to computes per each of the contents as weight for a period for which the content has been checked out or for the genre of the content or for playing time of the content [e.g., '288 Medina: col. 13, lines 1-9; col. 93, line15].

As to claims 43, 50, 57 and 64:

Except all the features recited in claims 41, 48, 53, 55, 60, and 62, the combined system of Bieganski and Medina further discloses that the system comprising means for adding new filtering data [e.g., '288 Medina: col. 11, lines 19-22].

### ***Response to Arguments***

Applicant's arguments with respect to claims 41-43 and 48-68 filed on April 11, 2007 have been considered but are moot in view of the new ground(s) of rejection.

The examiner disagrees with applicant's arguments that "neither Bieganski nor Media alone, or in combination, disclose providing at least two filtering packages of selected content to an operable linked device for reproduction of the content selected, wherein the filtering criteria of the at least two filtering data sets may be defined by a user as recited in amended claim 41, or any claim depending therefrom."

In response to the above arguments that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., at least two filtering packages of selected content to an operable linked device for

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reproduction of the content selected, wherein, the filtering criteria of the at least two filtering data sets may be defined by a user) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition, even if the argued limitations were in the claims, the over broadly claimed limitations were read by the compatibility-modified recommendation systems that include collaborative filtering systems as disclosed by Bieganski et al. as discussed above. For example, the claimed "at least two filtering data sets" can be clearly met by the units: original recommendation set 301, the Shopping data set 303, the History data set 305 and the Rule set 306 at Fig. 3. Moreover, the claimed "an operable linked device for reproduction of the content selected" is met by the collaborative filter systems at col. 6, lines 1-47, wherein, the collaborative filter systems are deemed to have filtering criteria that being defined by the plurality of users to create a compatibility-modified recommendations of content product via content analysis, collaborative filtering and both that are selected by multiple users for other users.

Thus, based on the discussion above, the 35 U.S.C. 103(a) rejections are maintained.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:



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Miller et al. (U.S. Patent No. 6,108,493) which disclosed a computer system with methods to generate implicit rating and providing predication results to the user via a user interface in a collaborative filter environment .

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Points of Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y. Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mofiz Apu can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Susan Y Chen  
Examiner  
Art Unit 2161



June 29, 2007